

REMARKS/ARGUMENTS

The rejections presented in the Office action dated October 5, 2005 have been considered. Claims 1-21 are pending in the application. Claims 20 and 21 have been amended. Claim 20 has been amended to enhance terminology consistency, and not for purposes of patentability. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The title of the invention was objected to as not being descriptive. The Examiner has suggested a new title, which Applicant has adopted. It is understood that Applicant's adoption of the new title does not limit the claimed invention nor should such adoption be construed as acquiescence to the Examiner's characterization of the prior art relative to Applicant's claimed subject matter.

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 21 also stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended claim 21 to properly recite statutory subject matter. Applicant's amendment to claim 21 also overcomes the Examiner's concern regarding indefiniteness. Applicant submits that amended claim 21 complies with both 35 U.S.C. § 101 and 35 U.S.C. § 112.

Claims 1-4 and 8-14, 19, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over UK Patent Application GB 2289191 to *Motorola*. (hereinafter “*Motorola*”).

Claims 5 and 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Motorola* in view of U.S. Patent No. 6,178,388 to *Claxton* (hereinafter “*Claxton*”). Claims 6 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Motorola* in view of U.S. Patent Publication No. 2004/0204123 to *Cowsky, III et al.* (hereinafter “*Cowsky*”). Claims 7 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Motorola* in view of U.S. Patent Publication No. 2004/0248594 to *Wren, III* (hereinafter “*Wren*”). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Motorola* in view of U.S. Patent No. 6,871,074 to *Harris et al.* (hereinafter “*Harris*”).

Motorola discloses a handover management method, the basic operation of which is described in Figures 2a and 2b. The *Motorola* handover management method first checks the possibility to carry out an intra-system handover, and if such handover is not possible, an inter-system handover on the basis of previous inter-system handovers is carried out.

Motorola does not teach or suggest checking the state of a user interface component, for instance a display or keypad. *Motorola*’s checking of the state of a call, for example, can not be equated to checking the state of a user interface component. *Motorola* also does not disclose a specific checking step for checking if a call is inappropriate. Instead, as illustrated in Figure 2a, the method is simply applied when a call is in progress (step 30, for example, is not a checking step). Further, *Motorola* does not disclose a method for deciding whether or not to apply a handover algorithm.

The Examiner can not rely on *Motorola* or other art of record for disclosing or suggesting several features of Applicant’s claims, as these features are clearly missing from the *Motorola* disclosure. Rather, the Examiner merely states, without support, that several of Applicant’s claimed features are “inherent.”

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

To support the rejection of Applicant’s claims 1-4 and 8-14, 19, and 21, the Examiner argues that checking the state of a mobile terminal’s user interface within the context of Applicant’s claimed invention is inherently present in all mobile terminals. The

Examiner further posits that applying a handover algorithm on condition that the current state of the user interface is active as established from a state check of the user interface is also inherently present in all mobile terminals.

Yet, the Examiner has been unable to support these assertions by relying on demonstrable evidence. Respectfully, these possible attributes deemed inherent by the Examiner are simply not present in the *Motorola* teachings or suggestions (or in the other art of record), but arise only from mere supposition proffered by the Examiner.

The Examiner's contention that a distinguishing feature of Applicant's claims is "inherently" known is tantamount to taking official notice that this element of Applicant's claims constitutes a fact outside of the record which is capable of instant and unquestionable demonstration as being well known or obvious to one skilled in the art. Applicant respectfully disagrees and requests that the Examiner produce a reference that supports the Examiner's assertion that *Motorola*'s apparatus/method inherently checks the state of a mobile terminal's user interface and further applies a handover algorithm on condition that the current state of the user interface is active as established from a state check of the user interface.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicant respectfully submits that *Motorola* does not teach every element of claims 1-4 and 8-14, 19, and 21, expressly or inherently, and therefore fails to anticipate these claim.

With regard to the obvious rejection of claims 1-4 and 8-14, 19, and 21, three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there

must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Applicant respectfully traverses the rejection since the prior art fails to disclose all the claim limitations and there would be no motivation to combine the references as proposed by the Examiner.

As is discussed above, *Motorola* fails to teach or suggest several features of Applicant's claimed invention. For example, there is no suggestion or contemplation of checking the status of a user interface component in *Motorola*, or towards any steps or means for defining whether or not to apply a handover algorithm. It is to be noted that, although handover features in *Motorola* are applied during an active call (i.e., the procedure in Figure 2A is initiated in connection with starting of a call), this teaching would not provide one skilled in the art with an indication towards a specific handover procedure by which, as currently claimed, the handover algorithm is applied if the state of the user interface component is active.

Motorola provides no teaching on any means or steps for determining handover algorithm usage. The only teaching that is related to handover algorithm initiation is that a call is in progress when the handover related steps in *Motorola* are carried out. The application of the handover algorithm during the call in *Motorola* does not require any specific checking step for determining the state of the terminal, but the handover algorithm is initiated automatically when a call is established.

These features are tacitly acknowledged to be missing from *Motorola* by the Examiner's reliance on inherency. Applicant respectfully disagrees with the Examiner's reliance on inherency and questions the legitimacy of taking official notice of important features of Applicant's claims.

Applicant further asserts that the requisite motivation to combine reference teachings as proposed by the Examiner is missing. *Motorola*'s silence on checking the state of a mobile terminal's user interface for any purpose would clearly not motivate one skilled in the art to combine features of the prior art to arrive at Applicant's claimed subject matter.

Assuming, *arguendo*, that *Motorola* did teach or suggest checking the state of a mobile terminal's user interface, *Motorola*, alone or in combination with knowledge

possessed by one skilled in the art, simply does not provide the requisite motivation to check that state of a mobile terminal’s user interface for the specific purpose of applying a handover algorithm on condition that the current state of the user interface is active as established from a state check of the user interface. Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking official notice of the above-discussed “facts” disregards the requirement of analyzing Applicant’s claimed subject matter “as a whole.” Applicant respectfully reiterates the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03.

Applicant contends that reasonable doubt exists regarding the circumstances justifying the Examiner’s exercise of official notice, and requests that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Allegations concerning specific knowledge of the prior art . . . should be supported and the Applicant should be given the opportunity to challenge the correctness of such assertions and allegations (MPEP § 2144.03). Applicants reserve the opportunity to respond to the Examiner’s comments concerning any such judicially noticed facts.

Concerning the rejection of various dependent claims in paragraphs 10-13 of the Office Action, Applicant disagrees with the Examiner’s characterization of the reference teachings and unsupported conclusions of obviousness of these claims. *Claxton* discloses a device with a flip cover. *Cowsky* discloses that a keypad lock may be applied in a mobile terminal. *Wren* mentions that a screen saver may be applied in an electronic device. *Harris* discloses a solution in which a terminal is transitioned from an originally applied RF channel if the user has not sent or received data for a timer period greater than a threshold. Even if one or more of these references could be combined with *Motorola*, the motivation of which is however refuted, the combination would still fail to provide any motivation regarding the specific application of a handover algorithm on the basis of checking the state

of a user interface component and only when the current state of the user interface component is active.

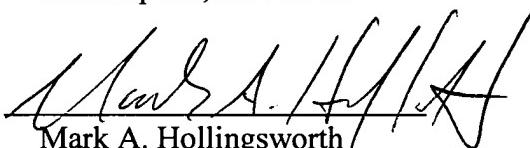
For at least these reasons, Applicant respectfully asserts that the Examiner has failed to establish *prima facie* anticipation or obviousness of Applicant's claims 1-21.

New claims 22-27 have been added. Support for newly added claims 22, 24, and 26 can be found in paragraphs [0006], [0018], and [0031]-[0035], for example. Support for newly added claims 23, 25, and 27 can be found in paragraph [0022], for example.

If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at 952.854.2700 to discuss any issues related to this case.

Respectfully submitted,
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